REMARKS

Claims 1-39 are pending in the present invention. Claims 1, 4, 10, 14, 19, 23, 27, 32 and 36 have been amended. Support for these amendments can be found in the entire specification, for example, lines 4-26 on page 5, including lines 17-18 which recite: "Each question may be ranked according to importance and without the need to specify which questions should follow each answer." Further support for the amendments can be found on pages 9-11 of the specification.

§ 102 (a) Rejections

Claims 1, 4-14, 17-27 and 30-39 were rejected under 35 U.S.C. § 102 (a) as being anticipated by Rofrano, US 6,035,283 (hereinafter "Rofrano").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner's rejection is respectfully traversed because each and every element as set forth in Applicant's Claim 1 is not found, either expressly or inherently described in Rofrano.

Claim 1 has been amended to recite "said host system ... selects said electronic questions in order of a ranked importance, said ranked importance independent of any previous answers provided by said customer." This limitation is not taught by Rofrano. In contrast, Rofrano teaches that a database is populated by having a sales agent enter questions and then possible answers. The possible answers can then be followed up with more questions, which in turn can have more answers and so forth. Each answer has the ability to store information about product features and/or to link to other lines of questioning. This question and answer tree structure is depicted in FIG. 1 of the Rofrano

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patent. (Rofrano; col. 3, lines 34-51.) When the processing described by the Rofrano patent is executed by a customer, the first question at the root of the tree is presented to the customer and the customer receives new questions in an order that is based on how the customer answered the previous question. (Rofrano; col. 4, lines 31-42 and FIGS. 1 and 2.) Rofrano does not teach "said host system ... selects said electronic questions in order of a ranked importance, said ranked importance independent of any previous answers provided by said customer" as recited in Applicant's Claim 1. Therefore, Claim 1 is patentable over Rofrano.

Claims 14 and 27 are believed to be allowable for at least the reasons given for Claim 1. Claims 4-13 depend from Claim 1, Claims 17-26 depend from Claim 14 and Claims 30-39 depend from Claim 27. Thus, these claims are believed to be allowable due to their dependencies on Claims 1, 14 and 27. Thus, withdrawal of the claim rejections under 35 U.S.C. § §102 (a) is respectfully requested.

§ 103 (a) Rejections

Claims 1, 4-14, 17-27 and 30-39

Claims 1, 4-14, 17-27 and 30-39 were rejected under §103(a) as obvious over Rofrano in view of IBM Technical Disclosure Bulletin Number NN9311427 "Encoding Data into Irrational Magic Numbers for Fast Searching and Comparing" dated November 1, 1993 ("IBM TDB").

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016,

1023 (Fed. Cir. 1996). Applicant respectfully traverses the rejection because all elements of Applicant's claimed invention are not disclosed in Rofrano in view of the IBM TDB.

Claims 1 is believed to be allowable for at least the reasons given above for the §102(a) rejection.

In addition, the Examiner has stated that the "applicant may argue that the method of Rofrano does not provide a separate listing in numerical order which according to the specification makes for easier manipulation of tree like structures." Applicant respectfully submits that "questions in order of a ranked importance, said ranked importance independent of any previous answers provided by said customer", as recited in Claim 1, does not make for easier manipulation of tree like structures but instead allows for questions to be presented to the customer "independent of any previous answers provided by said customer." Therefore, the addition of the IBM TDB does not cure the deficiencies of Rofrano and Claim 1 is patentable over Rofrano in view of the IBM TDB.

Claims 14 and 27 are believed to be allowable for at least the reasons given for Claim 1. Claims 4-13 depend from Claim 1, Claims 17-26 depend from Claim 14 and Claims 30-39 depend from Claim 27. Thus, these claims are believed to be allowable due to their dependencies on Claims 1, 14 and 27. Thus, withdrawal of the claim rejections under 35 U.S.C. § §102 (a) is respectfully requested.

Claims 2-3, 15-16 and 28-29

Claims 2-3, 15-16 and 28-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rofrano in view of IBM TDB and further in view of Official Notice.

As described above, Rofrano and the IBM TDB do not teach all of the limitations of Claim 1. Thus, the combination of Rofrano, IBM TDB and Official Notice does not render Claims 2-3 obvious.

Claims 14 and 27 are believed to be allowable for at least the reasons given for Claim 1. Claims 15-16 depend from Claim 14 and Claims 28-29 depend from Claim 27. Thus, these claims are believed to be allowable due to their dependencies on Claims 14

and 27. Thus, withdrawal of the claim rejections under 35 U.S.C. § §103 (a) is respectfully requested.

<div align="center"><u>Conclusion</u></div>

In view of the forgoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to this effect is requested.

If there are any charges due in connection with this response, please charge them to Deposit Account 09-0459 maintained by Applicant's Assignee.

Respectfully submitted,

By: _____
Anne Davis Barry
Registration No. 47,408
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 23413

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